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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,201

03/19/2004

Chandrakant Govind Naik

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EXAMINER

BERNHARDT, EMILY B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,201

Applicant(s)

NAIK ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claims 1-2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In the preamble of claim 1 the phrase “..extracted from....having antibacterial activity” requires clarification as to scope being claimed. The phrase can be interpreted to denote the source from where the compound can be obtained resulting in a product-by-process claim or the manner in which the compound is purified. It is not at all clear if applicants are claiming a “purified” form of the compound which is important given its existence in nature.

2. Claim 2 fails to further limit claim 1. Reciting an intended use in compound /composition claims is given no material weight. Note In re Tuominen 213 USPQ 89. If applicants’ intent is to claim a use, standard method claim terminology is suggested.

3. In claim 5 “comprising” is open-ended (and thus unclear as to intended scope) when reciting intended solvents for the extraction step. “Consisting of” is suggested if only the 2 recited solvents are intended.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled

in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to provide an enabling disclosure. The ultimate source of instant compound is from the leaves of a mangrove plant found in a particular region in western India. From this plant is extracted a fungus. While applicants identify the strain which was extracted from the leaves and identify where a deposit of such has been made in India, it is not apparent that said depository is one recognized under the Budapest Treaty. Note the requirements set forth in the MPEP 2404.01 and see MPEP 2405 for when the depository is not recognized under the Budapest treaty, the necessary requirements to comply with 35 USC 112, first paragraph.

Claims 3-14 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claims lacking essential reaction parameters critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Note specification on p.6 teaches ultimate source of the *pencillum* fungus as “mangrove-associated” not present in claim 3 and claims dependent thereon except for 15 which specifies the strain.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to non-statutory subject matter. The claims as recited lack novelty i.e. the compound is not new as it is found in mangrove plants. As discussed in the above 112 rejection under par.two, the claim language does not distinguish the crude form of the compound present in said plants vs. from that isolated and purified by applicants' process. Note In re Bergstrom 166 USPQ 256 which is on point.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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A handwritten signature in cursive script, appearing to read "E Bernhardt".

Emily Bernhardt
Primary Examiner
Art Unit 1624